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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,436	03/31/2004	Kirti Srivastava	4062-117	3805
23117 7590 02/27/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER DESTA, ELIAS	
			ART UNIT 2857	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/813,436

Applicant(s)

SRIVASTAVA ET AL.

Examiner

Elias Desta

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Detailed Action

Explanation of rejection

Claim rejection – 35 U.S.C. 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-10 are rejected under 35 U.S.C. 101. The claimed invention is directed to non-statutory subject matter.

In reference to claims 1-5: the claimed invention is directed to a non-statutory subject matter because “obtaining an expression for mean heat flow and variance in heat flow” is not “useful, concrete and tangible”.

The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. Referring to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" in determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

The step of obtaining an expression of mean heat flow and variance in heat flow data does not constitute a "useful, concrete and tangible" result. The invention is intended for "creating an analytical closed form model of the Earth's surface area" for a specific application, and yet having an expression of "mean" and "variance" heat flow does not make a concrete result. However, the result is useful and has a potential to do something concrete and tangible if it is carried out by further process. However, in the absence of a useful, concrete and tangible result, the claims are deemed to be non-statutory.

In reference to claims 6-10: The claimed invention is directed to a non-statutory subject matter with no practical application (even if written in a method/process form). Law of nature and natural phenomena are the exceptions to statutory subject matter. For instance, "quantification of the earth's surface area heat flow" and "evaluation of the thermal state for related oil and natural gas" are governed by the thermodynamics law of nature and the claims do not exhibit a practical application. "An exponentially decreasing heat source and associated boundary conditions" actually are naturally occurring thermodynamics properties.

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The subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., Rubber-Tip Pencil Co. v. Howard, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); Mackay Radio & Telegraph Co. v. Radio Corp. of America, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.").

"An exponentially decreasing heat source and associated boundary conditions" actually are naturally occurring thermodynamics properties. The claims in the instant case are related to a mathematical expression describing thermodynamic properties. No new device or idea is developed to make the application useful. "Obtaining an expression for mean heat flow and variance in heat flow" does not produce concrete and tangible result. The invention "as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result.

Response to Argument

3. Applicant's arguments filed 1/24/2007 have been fully considered but they are not persuasive.

The Examiner still considers the claimed invention is directed to non-statutory subject matter with no concrete output (claims 1-5) and no practical application (even if written in a method/process form) (claims 6-10).

In reference to claims 1-5: The step of obtaining an expression of “heat flow” and “variance in heat flow” data does not constitute a “useful, concrete and tangible” result. The invention is intended for “creating an analytical closed form model of the Earth’s surface area” for a specific application, and yet having an expression of “mean” and “variance” heat flow does not sound like a concrete output

In reference to claims 6-10: Law of nature and natural phenomena are the exceptions to statutory subject matter. For instance, “quantification of the earth’s surface area heat flow” and “evaluation of the thermal state for related oil and natural gas” are governed by the thermodynamics law of nature and the claims do not exhibit a practical application. “An exponentially decreasing heat source and associated boundary conditions” actually are naturally occurring thermodynamics properties. Applicant is caught in between claims that are related to a mathematical expression describing thermodynamic properties and trying to make those claims statutory for purposes of examination. “Obtaining an expression for mean heat flow and variance in heat flow” does not produce concrete and tangible result. The invention “as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement, as stated in MPEP is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (see also Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

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Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elias Desta whose telephone number is (571)-272-2214. The examiner can normally be reached on M-Th (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571)-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elias Desta
Examiner
Art Unit 2857

- E.d

- February 17, 2007

